



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,465	09/24/2002	Hee Youn Choi	MM4515(PCT)	7655

7590 05/03/2004

Anderson Kill & Olick
1251 Avenue of the Americas
New York, NY 10020

EXAMINER

ISSING, GREGORY C

ART UNIT	PAPER NUMBER
----------	--------------

3662

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,465

Applicant(s)

CHOI ET AL.

Examiner

Gregory C. Issing

Art Unit

3662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,8,9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,8,9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3662

1. The substitute specification filed 1/14/04 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: it does not correct the numerous grammatical and idiomatic errors that abound therein. The only apparent changes to the specification are numeric identifications corresponding to the drawings.

2. A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because the specification is replete with errors of a grammatical and idiomatic nature.

A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c).

3. New corrected drawings are required in this application because the drawings supplied on 1/14/04 are not clear, the drawings consist of numerous shaded areas obfuscating the elements, the connections are not clear, for example between processor 11 and manager 14 and bluetooth 15. Figures 1A, 1B and 2 are described as prior art and should be indicated as such. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "fourth connecting means" of claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Art Unit: 3662

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

Art Unit: 3662

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

5. The claim amendments are informal since they do not correctly show the amendments with respect to the claims as previously presented, see for example, claims 3, 4, 8, 9, 11, and 12.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 3, 4, 8, 9, and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The claims remain indefinite for the numerous reasons set forth below.

9. In claim 3, it is unclear what is meant by "a hybrid method". It is unclear what is meant by "a bi-directional GPS system" in light of the fact that GPS satellites do not receive information from any users. It is not clear what is meant by "combining a GPS system . . . with a cellular/PCS network", i.e. a system and a network, when in fact the method appears to be directed to a user mobile device. It is not clear what is meant by "caller's postal address inclusive of street number" since a postal address is a fixed address corresponding to a domicile or place of mail delivery; additionally, it is not understood what good a fixed postal address would accomplish in the instant embodiment since the postal address would be fixed and the purpose is to locate mobile users. Additionally, does the language "inclusive of street number" mean that something else related to position is transmitted or that the postal address is the street number. The language "wherein the coordinates" and "in the database" lack proper antecedent

Art Unit: 3662

basis. The language “*can be converted*” is indefinite since it fails to clearly and distinctly define the metes and bounds of the subject matter; that it can be converted does not define that it is converted but merely has the capability of being converted which would be true for any positional data. It is not clear if the steps of the method relate to steps all of which are inclusive at a single mobile user or if some steps are provided elsewhere or if all of the steps are provided at a base station. As best understood, the steps appear to set forth displaying a user’s address to himself after receiving GPS data using a connection of conventional elements of an integrated GPS receiver/cellular telephone. This is unclear in each of the independent claims.

10. In claim 4, the language “to verify time and location data *on* the network” is not understood. The language “as a the method mentioned in substitute for a conventional ID and/or credit card” is not understood.

11. In claim 8, it is unclear what is meant by “a bi-directional GPS system”. The language “*can be converted to ASCII*” is indefinite for reasons set forth in paragraph 8 above. It is not clear what is meant by “caller’s postal address inclusive of street number” for reasons set forth above. The language “the coordinates”, “the caller user”, “the database”, “the receiving user”, and “said Receiver” lack proper antecedent basis. The “fourth connecting means” is not understood; this is not shown in the drawings or adequately disclosed, that is a single connecting means connecting the hybrid processor to the ROM device and the function manager. It is unclear why “said Receiver” and “the External I/O interface” are capitalized.

12. In claim 9, “the cellular user” is undefined. It is not clear what is meant by “said data storage memory is used for . . . verify time and location data on the network as a substitute for a

Art Unit: 3662

conventional ID card and/or credit card.” The parenthetical expressions are indefinite since it is unclear if this is a limitation or not.

13. In claim 11, it is not clear what is meant by “method . . . that performs said I/O interface.” It is not clear what is meant by “that performs said I/O interface for multipurpose functions by implementing a variety of data gained from the database.”

14. In claim 12, it is not clear what is meant by “system . . . that performs said I/O interface.” It is not clear what is meant by “that performs said I/O interface for multipurpose functions by implementing a variety of data gained from the system the database.”

15. In claim 13, it is unclear what is meant by “a hybrid method”. It is unclear what is meant by “a bi-directional GPS system” for reasons previously set forth. It is not clear what is meant by “combining a GPS system . . . with a cellular/PCS network”, i.e. a system and a network, when in fact the method appears to be directed to a user mobile device. It is not clear what is meant by “caller’s postal address inclusive of street number” for reasons set forth above. The language “the coordinates” and “the database” lack a proper antecedent basis. The language “can be converted” is indefinite for reasons previously set forth. The parenthetical expression is indefinite since it is unclear if this is a limitation or not, particularly in light of the language in the claims that defines time and location and identity.

16. In claim 14, the parenthetical expression is indefinite since it is unclear if this is a limitation or not, particularly in light of the language in the claims that defines time and location and identity. The language “the cellular user” lacks a proper antecedent basis. The language “to provide a substitute card system and/or credit card” is indefinite since an original card has not been previously defined so a substitute has no meaning that can be attributed thereto. The

Art Unit: 3662

language “the network memory” and “the cellular user” lack proper antecedent basis. It is not clear how the limitations of claims 9 and 14 differ.

17. Although the Examiner has attempted to list all of the noted defects, this should not be considered complete and the applicant should carefully review the claims fully.

18. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

19. Claims 3, 8, and 13-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Obradovich et al.

20. Obradovich et al disclose an integrated personal communication device PCD with a GPS receiver and display wherein the PCD (Figure 4 and Figure 24, e.g.) is capable of transmitting positional information derived from a GPS receiver to a security monitoring station as well as receiving positional information from a central server or other users using a telecommunication link. The embodiment described in Figure 27 includes a common universal data structure that may incorporate postal encoding and street centering encoding. The device includes as shown in Figure 4, a conventional cellular transceiver 29C, a GPS receiver 243, external I/O interface 26, 27, 28B, 25K, a display 28A, a processor and storage means 22/23. Figure 5C shows various functions provided including the display of information from an onboard database based on the GPS data, including interstates, zip codes, area codes, highways etc. Figure 24 shows the software applications. It is inherent that each of the GPS and cellular telephone receive RF signals by nature of the fact that each system is known to transmit at radio frequencies and therefore include RF receivers. Moreover, in view of the fact that a digital processor is utilized,

Art Unit: 3662

the conversion to baseband is inherent. Identification information is met by any of the variety of identifications utilized, including phone number, E-mail address, etc. wherein it is well-known that caller ID is conventional in telephone communications. Access control is described in col. 9, while credit card authorization is described in col. 24.

21. The applicants argue that the prior art fails to teach an apparatus and method which combines GPS with a cellular network to function as a tracking network that will identify to the network the caller's postal address by way of street number and user ID and the global coordinates relative to time (see page 6, paragraph 2 of the response). Obradovich et al integrate GPS and cellular communication in a device PCD for use in tracking and teach the alternative use of GPS latitude/longitude data or street number info in addition to GPS longitude/latitude, see col. 26, par. 3 for example. Moreover, the conventional telephone, be it wireless or wired provides an ID code that is used for Caller ID functions in the normal manner. Furthermore, although not argued, the claims have been amended to set forth, without clarity, use as verification for credit card use. This also is shown by Obradovich et al, see Figure 46 and its description, for example, at col. 24. However, claims 4 and 9 are so indefinite that a rejection over the prior art is not possible. Likewise, since claims 11 and 12 are so indefinite, a rejection over the prior art is not possible; Obradovich et al do show numerous varieties of information display based on information uploaded/downloaded from a remote site whether it be a central server or other user.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Davis discloses a combined GPS and cellular communication device comprising a GPS RF receiver 120, a cellular RF receiver 146, a baseband section 143, a memory 138, a

Art Unit: 3662

hybrid processor 142, and an external I/O 134. Bar et al disclose a combined position determining system/cellular telephone system wherein a database dynamically gathers and stores positional information as well as ID and time information of users wherein the positional information may include a street address (col. 4, lines 28-42). Bar et al also describe the conventionality of caller-ID features. Karp et al disclose a tracking system that combines wireless communication and position determining wherein it is disclosed to store positional information in the form of a street address translated from the form of longitude/latitude, see col. 9, par. 1.

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

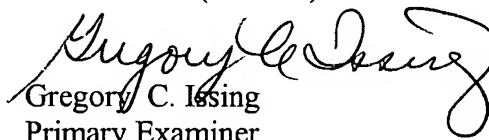
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3662

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (703)-306-4156. The examiner can normally be reached on Mon-Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (703)-306-4171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci
4/27/04